

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

U000-P02009US

Application Number

09/632/774

Filed

08/04/2000

First Named Inventor

Stacy Haitzuka

Art Unit

1751

Examiner

Nguyen, Tri V

The patent application owner requests review of the final rejection in the above-identified application.

No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

50,759

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Mark A Goldstein

Typed or printed name

805-230-1350

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05/10/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below\*.

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\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No.	: 09/632,774	Confirmation No.	2126
First Named Inventor	: Haitsuka		
Filed	: August 4, 2000		
TC/A.U.	: 3622		
Examiner	: Nguyen, Tri V		
Docket No.	: U000-P02009US		
Customer No.	: 33356		

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**Pre-Appeal Brief Request for Review**

Dear Sir:

A Final Office Action (FOA) was mailed February 10, 2006. Please review the FOA and consider the following remarks in a Pre-Appeal Brief Conference. In the below remarks, we identify both the presence of clearly improper rejections based upon erroneous citation to prior art references and the failure to present essential elements required to establish *prima facie* rejections. We therefore request that this matter be returned to the assigned examiner for preparation of a new non-final Office Action or that the matter be allowed.

***Claim Rejections - 35 USC § 103***

**A. Rejection of Claims 1, 7, 8, 11, 12, 15 and 21 citing Angles and Filepp**

The Office Action rejects these claims over the combination of Angles (US 5, 933,811) and Filepp (US 5,347,632). However, neither Angles nor Filepp teach the limitations for which they are cited. As such, the Final Office Action fails to adequately present a *prima facie* case of obviousness.

Generally, note that a **client application** and an **Internet browser** have distinctly different limitations as recited in the claims. The combination of references do not teach the client application and the browser application as claimed.

### **B. A Client Application and an Internet Browser Are Different**

Claim 1 recites a client application “commencing an online session with the online server, **the client application operating independently of an Internet browser and operating concurrently with the Internet browser.**” (emphasis added)

Claim 1 further recites “the client application causing a client window to be displayed on the output device, the client window remaining visible so long as the online session persists and **the client window displayed independently of a browser window generated by the Internet browser.**” (emphasis added)

Most of the actions recited in claim 1 are performed by the client application.

The Final Office Action fails to provide prior art that teaches a client application as claimed **and** an Internet Browser as claimed.

### **C. Problems with the Final Office Action**

#### **1. Failure to Assert *Prima Facie* Obviousness**

“To establish a *prima facie* case of obviousness, [ . . . ] the prior art reference (or references when combined) must teach or suggest all of the claim limitations.” MPEP 706.02(j). However, the Final Office Action does not do this. Although the Final Office Action includes a listing of limitations (pp. 2-3 in section 3.a-3.f) which the Examiner asserts are taught by the cited art, this listing of limitations does not correspond to any of the independent claims. Because the Final Office Action fails to show where each and every one of the claim limitations in taught or suggested in the cited art, the FOA fails to make a *prima facie* case of obviousness.

#### **2. Angles Is Wrongly Cited**

The FOA states that a browser of Angles teaches all or at least much of the functionality claimed of the client application. (FOA, p.2-3, sections 3.a-3.f) However this is just not so. The

browser of Angles cannot teach the client application recited in claim 1 because claim 1 also recites an Internet browser.

More specifically, the browser of Angles cannot teach or suggest a client application “commencing an online session with the online server” and “operating independently of an Internet browser and operating concurrently with the Internet browser”, “causing a client window to be displayed on the output device, the client window remaining visible so long as the online session persists and the client window displayed independently of a browser window generated by the Internet browser” as recited in claim 1 when the browser of Angles is an Internet browser.

### **3. It Is Wholly Unclear What Is Being Asserted To Teach The Internet Browser in Contrast to the Client Application**

The FOA asserts that a browser of Angles teaches much of the functionality of the claimed client application (FOA, p.2-3, sections 3.a-3.f), and that Filepp discloses an ad partition of a page (FOA, p. 3, lines 8-14). However, if the browser of Angles teaches the client application, and the teachings of Filepp are used to augment the functionality of the browser of Angles so that the combination teaches the client application, it is wholly unclear what is being asserted to teach the Internet browser.

### **4. Apparent Confusion of Angles As Applied to the Claims**

The FOA states that a browser of Angles teaches all or at least much of the functionality claimed of the client application. (FOA, p.2-3, sections 3.a-3.f) However, the FOA also states that “the teaching of Felipp [sic] are relied on to modify the Angles reference that recites the Internet, the web and the browser.” (FOA, p. 6, last sentence) It appears that in one location the FOA states that Angles is cited for teaching the client application (p.2-3, sections 3.a-3.f) and then later contradicts itself in stating that Angles is cited for teaching an Internet browser. This is confusing. We asked the Examiner to remedy this confusion in our Response dated April 9, 2006, p. 11., section 2, General Question. No clarification has been provided.

### **5. No Support for Arguments**

Although we respect the Examiner’s knowledge of Xerox software including Rooms, Viewpoint and Cedar, this software was not IBM-compatible. This software existed for use on Xerox and/or Unix based computers. If the Examiner wishes to assert teachings from prior art, the Examiner is required to provide citations and provide copies of the cited art. We requested

that the Examiner provide copies of the cited art if a rejection including references to this software is maintained. (Response dated 4/9/2006, p. 12, section 5.) No documents have been provided.

Similarly, if the Examiner wishes to cite that certain functionality was included in a version of Microsoft Windows existed at a particular time, the Examiner is required to provided a document in support. We similarly requested that the Examiner provide copies of the cited art if a rejection including references to Microsoft Windows is maintained. (Response dated 4/9/2006, p. 12, section 5.) No documents have been provided.

Other statements in the FOA appear to have no relevance to the claims. That, as the FOA states, Filepp discloses accessing a network to receive news, industry, financial, hobby and other information appears to be wholly irrelevant to the claims.

The FOA states that Filepp discloses that “applications, i.e. information events, are composed of a sequence of one or more pages opened at screen 414 of monitor 412 (col. 8, lines 64-66). We asked for clarification as to why this statement is being made. We received no clarification. (Response dated 4/9/2006, p. 13) Importantly, the cited sentence is followed by a section of Filepp that teaches a page or window that can have multiple page partitions (that is, panes). (Filepp, col. 8, line 66 - col. 9, line 9) Nothing more, nothing less. Please refer to the drawings (Figs. 3a and 3b of Filepp) in view of the cited portions of the specification. A persistent pane in a multi-pane window/page like that taught in Filepp does not teach or suggest the limitation of the “client application causing a client window to be displayed on the output device, the client window remaining visible so long as the online session persists and the client window displayed independently of a browser window generated by the Internet browser” recited in claim 1. Therefore, the FOA fails to assert a *prima facie* case of obviousness.

***Conclusion***

Because of the deficiencies in the FOA described above, we hereby request that the FOA be withdrawn and that a new, non-final Office Action be issued in its place or that the Application be allowed.

Respectfully submitted,



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Date: May 10, 2006

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